

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application, and for the personal interview conducted on February 21, 2007, with the Examiner and her supervisor. The application has been carefully reviewed in light of the Office action and interview, and this response provided thereto. The examiners agreed to reconsider the rejections in light of the interview.

The Examiner requested that the specification be amended to recite related applications. The amendments provided in this response list the related parent application. However, the Examiner also requests that the specification be amended to refer to an application (patent number 7,134,074, which has serial number 09/785,063) that is not a parent application. Applicants are aware of no requirement for such a reference, and thus prefer not to do so. The Examiner should cite any authority supporting such a requirement.

Claims 37-63 remain in this application. Claims 1-36 have been previously canceled. The examiner has acknowledged that claims 60-63 are directed to allowable subject matter.

The Examiner has rejected the claims for obviousness-type double patenting in light of patent number 7,134,074 (serial number 09/785,063) and application serial number 09/467,231. The rejections are traversed for the following reasons:

First, application serial number 09/467,231 has not issued into a patent. Therefore, the rejection must be held in abeyance until one of these applications issues as a patent.

Second, patent number 7,134,074 is a continuation-in-part of application serial number 09/467,231. This application is a continuation of application serial number 09/467,231. Thus, the '074 patent has matter that is not disclosed in this application, matter that may well be reflected in the claims.

The Examiner has not provided a proper rejection for obviousness-type double patenting in light of the ‘231 application. MPEP §804(II)(B)(1), second paragraph, states that:

A double patenting rejection of the obviousness-type is “analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103” except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Accordingly, the Examiner is required to make the following factual inquiries required by MPEP §804(II)(B)(1), paragraphs 3-7:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

The rejection is also required to make clear the following (MPEP §804(II)(B)(1) 8th paragraph):

- (A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

The Examiner has failed to make the proper factual inquiries and has failed to show the differences between the inventions defined by the conflicting claims or identify any reasons why one skilled in the art would find such differences to be obvious. Accordingly, the Examiner has not made a proper rejection for Obviousness-type double patenting. Consequently, although the Applicant asserts that the claims in the application are not obvious in light of the reference, applicant cannot respond to the rejections because applicant is not cognizant of what is considered, by the Examiner, as the obvious elements. Therefore, the Examiner must either withdraw the rejections, or provide the required factual inquiries and analysis in support of the rejection.

Claims 37, 39-45, 47, 49-54, and 55 were rejected under 35 U.S.C. §103(a) as being unpatentable over Smith *et al.* (Video Skimming and Characterization through the Combination of Image and Language Understanding Techniques). Claims 38, 46, 48, and 56-59 were rejected as above in further view of B. Arons (SpeechSkimmer). For the following reasons, the rejections are respectfully traversed.

Claim 37 recites a data processing apparatus including an “input unit operable to input content description data including a plurality of segments each for describing one of said plurality of scenes of media content”. Claim 57 recites a data processing apparatus including “input means for inputting content description data describing said plurality of scenes”. As discussed at the personal interview, the prior art does not teach any such apparatus.

Smith does not teach any data processing apparatus, and thus cannot teach any input to such an apparatus. As pointed out to the examiners at the personal interview, Smith is basically a research paper that discusses a supposedly new *method* of skimming video while preserving the important information found in the video (see abstract), so that a viewer can skim the video but still capture the most important aspects of the video. See, e.g., the Abstract. Smith describes an *algorithm* to create skim videos (id. See also the Conclusion). But Smith does not teach any data processing *apparatus* inputting content description data for performing the disclosed method. In fact, Smith makes clear that his method relies on *manual* processes (stating that the “manually created skims in the initial stages of the experiment help test the potential visual clarity and

comprehension of the skims” --see section 3.5, first sentence). There is no teaching of any “input unit operable to input content description data” and there is no teaching of any “output unit” as recited in the claims. Arons does not overcome the Smith shortcomings. Thus, claims 37 and 57, and the claims dependent thereon, are patentable over Smith.

Claims 37, 57, and 47 all recite inputting of content description data that includes a “context attribute” having a “value for describing a context of said media content”. As also discussed at the personal interview, the cited prior art fails to teach any such “context attribute”.

Smith does not teach any “content description data” as defined by the claims. Note that this “content description data” is recited by claims 37 and 57 as being *input* into an *apparatus*. There is no teaching that any data with the attributes of the content description data, as recited in the various claims, is input into any apparatus. Note further that the attribute has a *value* that is for describing a *context* of the media content. At most, Smith uses information in the media content itself for the skimming (i.e., basically condensing the data into a smaller amount for quick viewing). There is no data provided that *describes* such content disclosed by the reference as being input into any device. In addition, note that the segments outputted by the output unit are also part of the *content description data*, whereas all Smith appears to provide is skimmed video based on an analysis of the video itself. Thus, claims 37 and 57 are patentable over Smith for these reasons as well.

Furthermore, the Examiner admits in the Office action that Smith does not teach a “*value* representing a degree of *contextual importance*” (emphasis added), but states that Smith teaches “prioritized video frames”. The Examiner fails to explain how “prioritized video frames” would make the claimed material obvious, when Smith clearly does not suggest that the priority is a *value*, of an attribute of data, that is related to a degree of *contextual importance*. As discussed at the personal interview, there is no teaching of any “*value*” being associated with this cited “*priority*”. The prior art does not teach any value. Instead, Smith merely appears to teach a method of analyzing the video itself, and merely prioritizing the important (versus non-important), frames. There is no teaching of

any value associated with this priority. Accordingly, the claims are patentable over Smith.

Furthermore, the Examiner is clearly applying hindsight reasoning, by relying on the instant application for the motivation for modifying the reference, because there is no suggestion of using any “value” for the priority discussed in the reference. This is not proper, and the rejections cannot stand.

Finally, Aron does not overcome any of the Smith shortcomings. Aron is directed to audio skimming, and thus is not applicable to a video apparatus. It does not disclose any content description data that describes media content comprised of a plurality of scenes, because no such content is discussed. The reference does not disclose any input unit for inputting content description data as recited in the claims. Thus, the claims are patentable over the combination of references as well.

Finally, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish prima facie obviousness (Id.). The prior art must also suggest the desirability of the combination (Id.). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness.

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner

must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references.

Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

Finally, at the personal interview the Examiner requested clarification of the function of outputting the segments. The claims refer to content description data including a “plurality of segments each for describing one of said plurality of scenes of media content”. Thus, the outputted segments are part of the description data, not the media content. See, for example, Figure 1, which shows separate inputs of media and description data. Also note Figure 2, which shows a breakdown of an embodiment of the description data with “segments” shown at the lowest level. Hopefully, this explanation will clarify this matter for the Examiner.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32161US2.

Respectfully submitted,
PEARNE & GORDON, LLP

March 1, 2007

By: / Robert F. Bodi /
Robert F. Bodi, Reg. No. 48,540

1801 East Ninth Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700